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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,194	11/12/1999	HENRICUS A. W. VAN GESTEL	PHN-15.588A	1374

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EXAMINER

LE, UYEN T

ART UNIT PAPER NUMBER

2163

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/439,194

Applicant(s)

VAN GESTEL, HENRICUS A. W.

Examiner

Uyen T. Le

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 16-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3 February 2006 have been fully considered but they are not persuasive.

Applicant argues that the reasons for reopening the prosecution are mischaracterized. The examiner disagrees for the following reasons: claims 13, 16-23 were not previously rejected under obviousness type double patenting. Claims 16, 22 and 13, 18 were not objected to as substantial duplicates in the previous Office Action.

Applicant argues that applicant cited some guidelines for patentability for signals mentioned in the MPEP and the examiner has failed to respond to this citation. In response, applicant is advised that the Office is following the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility published 26 October 2005. Under the present Interim Guidelines, signal claims are non-statutory.

Applicant argues that objection to claims 13, 18 and 16, 22 raised at this stage is improper because they recite different limitations. In response, the examiner disagrees. The objection is proper because the previous Office Action was made non-final again. Claim 16 merely differs from claim 13 by reciting "electromagnetic signal" instead of "data signal". Claim 18 depends respectively from claims 17, 16, thus includes all the limitations of claims 16, 17. Claim 22, which recites the same limitations of claims 16, 17, 18, is a duplicate of claim 18.

Applicant argues that claims 13 and 16-23 are unobvious over claims 7-10 of the '886 patent. The examiner disagrees. The claimed signals merely consist of data fields arranged in the specific manner of claims 7-10 of the '886 patent.

Applicant argues that applicant is not aware of any case or statutory law that refers to limitations as optional. In response, the examiner considers claim language such as "other operations can be performed", "the identifiers need not be changed" as optional because there is no active step required in the operation recited in claim 18.

Applicant is informed that consultation with SPE Don Wong has been conducted resulting in this Office Action, which repeats the previous Office Action mailed 3 November 2005.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 13, 16, 17, 19-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 13, 16, 17, 19-21 recite "a signal" an "an electromagnetic signal" consisting of mere arrangement of non-functional data that does not exhibit any functional interrelationship with the way in which computing processes are performed. Therefore, such descriptive material is considered non-statutory subject matter because it does not constitute a statutory manufacture, process, machine or composition of matter. Furthermore, signal claims are considered non-statutory under the present Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility published 26 October 2005.

Claim Objections

3. Applicant is advised that should claims 16, 22 be found allowable, claims 13, 18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 13, 16-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-10 of U.S. Patent No. 6,057,886. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 13, 16, 17 of the instant application recite a signal comprising the transmitted data items of claim 7 of US Patent No. 6,057,886. Thus claim 7 of the US Patent anticipates claims 13, 16, 17 of the instant application.

Claims 18 and 22 of the instant application recite a signal comprising the transmitted data items of claim 10 of the US Patent with some added optional or negative limitations. Note that claim 22 is an exact duplicate of claim 18. Note also that the limitation of claim 18 first two bullets are suggested by claim 10 operation of “comparing the number of received data items with the number indicated by the received field to determined whether all data items have been received” and “checking whether and which data items have not yet been received”. Claim 10 of the US Patent does not recite

- such updating is not conducted unnecessarily when the stored set of data items is still current and/or complete,
- other operations can be performed in lieu of such unnecessary updating, and
- the identifiers need not be changed as the range of data items currently transmitted changes.

However, these optional “can be” or negative limitations “need not” do not require any action to be actually performed and seem to be logically resulting from what is performed in claim 10 of the US Patent.

Claims 19, 20, 23 of the instant application merely recite the limitations of claim 9 of the US Patent in different words.

Claim 21 of the instant application merely recite the limitations of claim 8 of the US Patent in different words.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T. Le whose telephone number is 571-272-4021. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

14 April 2006



UYEN LE
PRIMARY EXAMINER